REMARKS

Applicants appreciate the thorough examination of the present application as evidenced by the Office Action of February 7, 2007. In particular, Applicants appreciate the Examiner's consideration of Applicants' information disclosure statements. Applicants respectfully submit that the pending claims are in condition for allowance for at least the reasons discussed herein.

The Section 103 Rejections

A. Claims 1, 6-13, 25, 26 and 29-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over United States Patent Application Publication No. 2003/1037495 to Canova (hereinafter "Canova") in view of United States Patent No. 6,977,645 to Brosnan (hereinafter "Brosnan"). *See* Office Action, page 2. Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by the cited combination. For example, Claim 1 recites:

> A portable electronic device, comprising:
> a housing;
> a display integrated with the housing;
> **a thumb-operable input device positioned on a side of the housing;**
> **an indicator on the display operatively associated with the thumb-operable input device, the indicator being positioned on the display to highlight and/or select menu items on the display responsive to input received at the thumb-operable input device.**

Independent Claims 13 and 25 include similar recitations to the highlighted recitations. Applicants respectfully submit that at least the highlighted recitations are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Office Action provides Canova as providing all of the recitations of Claim 1 except "the indicator on the display operatively associated with the thumb-operable input device (116)." *See* Office Action, page 2. However, the Office Action points to Brosnan as providing the missing teachings. *See* Office Action, page 2. Applicants respectfully disagree. In particular, the Office Action points to elements 111 and 119 of Figure 9 of Canova as teaching the thumb operable input device as recited in Claim 1. *See* Office Action, page 2. Element 119 of Canova is a switch "for activating and deactivating a text entry area." *See* Canova, paragraph 27. The switch is positioned on the side of the handheld computer 100 of Canova. However, as discussed in Canova, the switch 119 only activates or

deactivates the text entry area, data must actually be entered using an alternative means, for example, using a stylus on the text entry area.

In stark contrast, Claim 1 recites "a thumb-operable input device positioned on a side of the housing" that allows one handed operation of the handheld device. Nothing in Canova discusses one handed thumb operation of the handheld computer 100 of Canova. In fact, nothing in Canova discusses one handed operation of the handheld device using the thumb. Accordingly, Claim 1 is patentable over the cited combination for at least these reasons.

As discussed above, the Office Action admits that nothing in Canova discusses the indicator on the display operatively associated with the thumb-operable input device as recited in Claim 1 and points to Brosnan as providing the missing teachings. *See* Office Action, page 2. The cited portion of Brosnan is a highlight bar 16 positioned on a front of the housing that can be used to highlight particular menu items. *See* Brosnan, column 4, lines 44-47. However, nothing in Brosnan discusses positioning the highlight bar 16 on a side portion of the housing so that it is thumb operable. Accordingly, nothing in either Canova or Brosnan discloses or suggests a thumb-operable input device positioned on a side of the housing or an indicator on the display operatively associated with the thumb-operable input device, the indicator being positioned on the display to highlight and/or select menu items on the display responsive to input received at the thumb-operable input device as recited in Claim 1. Thus, Claim 1 is patentable over the cited combination for at least these additional reasons.

Furthermore, there is not motivation to combine the cited references as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. *See In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

The Office Action states:

> Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Canova's handheld computer with Brosnan's a bar which highlight menu, because this will provide a user with a visual indicator to easily see information.

See Office Action, page 3. This motivation is, at most, a motivation based on "subjective belief and unknown authority," the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. In other words, the Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action. If the motivation provided in the Office Action were adequate to sustain the Office's burden, then anything that would "provide a user with a visual indicator to easily see information" would render a combination obvious. This cannot be the case. Accordingly, the statement in the Office Action with respect to motivation does not adequately address the issue of motivation to combine as discussed in *In re Sang-su Lee*. Thus, it appears that the Office Action gains its alleged impetus or suggestion to combine the cited references by hindsight reasoning informed by Applicants' disclosure, which, as noted above, is an inappropriate basis for combining references.

Accordingly, Applicants respectfully submit that independent Claims 1, 13 and 25 are patentable over the cited combination for at these additional reasons. Furthermore, the dependent are patentable at least per the patentability of the independent base claims from which they depend. Accordingly, Applicants submit that independent Claims 1, 13 and 25 and the claims that depend therefrom are in condition for allowance, which is respectfully requested in due course.

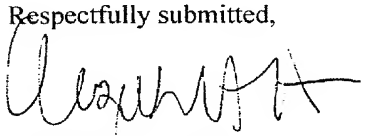
B. Claims 2, 14 and 18-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Canova in view of Brosnan in further view of United States Patent No. 6,570,596 to Frederiksen (hereinafter "Frederiksen"). *See* Office Action, page 4. As discussed above, the dependent claims are patentable over the cited references for at least the reasons discussed above with respect to independent Claims 1, 13 and 25 from which they depend.

C. Claims 3, 4, 5, 15, 16, 17, 27 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Canova in view of Brosnan in further view of European Application No. EP 1113385 to Jari *et al.* (hereinafter "Jari"). *See* Office Action, page 6. As discussed above, the dependent claims are patentable over the cited references for at least the reasons discussed above with respect to independent Claims 1, 13 and 25 from which they depend.

CONCLUSION

Applicants respectfully submit that pending claims are in condition for allowance for at least the reasons discussed above. Thus, allowance of the pending claims is respectfully requested in due course. Favorable examination and allowance of the present application is respectfully requested.

Respectfully submitted,



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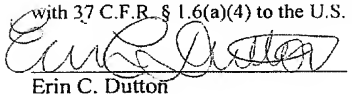

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